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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,219	08/29/2001	Yuji Suzuki	81800.0166	8883
26021	7590	01/25/2006	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			MENBERU, BENIYAM	
		ART UNIT	PAPER NUMBER	
		2626		

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/943,219	SUZUKI ET AL.
	Examiner	Art Unit
	Beniyam Menberu	2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 November 2005.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-18 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

***Response to Arguments***

1. Applicant's arguments filed November 3, 2005 have been fully considered but they are not persuasive. JP401318456A to Fukuda discloses of disconnecting a line to a first facsimile device when the device is incapable of receiving data (page 7, lines 15-16; page 8, lines 18-21, reference 231; page 8, lines 15-21) and transferring to another facsimile device. By this method the first facsimile which has failed to operate is maintained closed while the other facsimile performs the communication (page 9, lines 4-7). Applicant fails to disclose for how long the circuit is maintained closed but rather it is closed when recording unit fails. Even though the independent claims 1, 7, 8, and 10 state "maintaining the state of closing the circuit" it does not mention for how long or until what condition that this closing of the circuit is maintained. Thus Fukuda teaches the limitations of claims 1, 7, 8, and 10.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by JP401318456A to Fukuda.

Regarding claim 10, Fukuda disclose a communication terminal comprising:

a network control unit for closing and releasing a circuit (page 7, lines 13-14, reference 233);

an operating key for making the network control unit release the circuit (It would be inherent that a hook key which reads on operating key is used to release the circuit of the facsimile system of Fukuda (page 7, lines 12-13));

a speaker (Since Fukuda discloses an alarm system it would be inherent that there is a speaker to output the alarm (page 7, lines 15-16));

a recording unit for recording image data in a recording medium (page 7, line 10, reference 215); and

a control unit which refuses an incoming call by maintaining the state of closing the circuit with the network control unit and outputs a melody which indicates the closing of the circuit, from the speaker, in the case the recording unit fails to operate (page 7, lines 15-16; page 8, lines 18-21, reference 231; page 8, lines 15-17).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 4638368 to Shimizu et al.

Regarding claim 1, Fukuda discloses a communication terminal comprising:

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a network control unit for closing and releasing a circuit (page 7, lines 13-14, reference 233);

an operating key for making the network control unit release the circuit (It would be inherent that a hook key which reads on operating key is used to release the circuit of the facsimile system of Fukuda (page 7, lines 12-13));

a recording unit for recording image data in a recording medium (page 7, line 10, reference 215);

a control unit which refuses an incoming call by maintaining the state of closing the circuit with the network control unit (page 7, lines 15-16; page 8, lines 18-21, reference 231). However Fukuda does not disclose a control unit that invalidates the operation and input of the said operating key in the case the recording unit fails to operate.

Shimizu et al disclose a communication apparatus that invalidates the operation and input of the said operating key in the case the recording unit fails to operate (column 6, lines 33-42).

Fukuda and Shimizu et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine invalidation of operating key taught by Shimizu et al and the facsimile system of Fukuda to implement invalidation of operating key used for releasing the circuit during recording unit failure.

The motivation to combine the reference is clear because during recording failure it would be advantageous to prevent user from interfering with the operation of

the facsimile machine so that the facsimile machine can recover from the failure (Shimizu et al: column 6, lines 33-37).

Regarding claim 18, Fukuda in view of Shimizu et al teach all the limitations of claim 1. Further Fukuda disclose a communication terminal according to claim 1 characterized in that the operating key for releasing the circuit is a hook key (page 7, lines 12-13).

6. Claims 2, 3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 4638368 to Shimizu et al further in view of U.S. Patent No. 5555104 to Todaka.

Regarding claim 2, Fukuda in view of Shimizu et al teach all the limitations of claim 1. However Fukuda in view of Shimizu et al does not disclose a communication terminal according to claim 1 comprising: an informing means for informing the fact that the operation of the said operating key is invalid.

Todaka discloses a communication terminal according to claim 1 comprising: an informing means for informing the fact that the operation of the said operating key is invalid (column 3, lines 27-30; column 4, lines 11-15, lines 15-23).

Fukuda, Shimizu et al, and Todaka are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the informing apparatus of Todaka with the system of Fukuda in view of Shimizu et al to implement informing device for the status of the operating key.

The motivation to combine the reference is clear because a user needs to know the status of an operating key through the use of an informing device.

Regarding claim 3, Fukuda in view of Shimizu et al further in view of Todaka teach all the limitations of claim 2. Further Todaka disclose a communication terminal according to claim 2 characterized in that the fact that the operation is invalid is informed when the operating key is operated (column 5, lines 53-67).

Regarding claim 5, Fukuda in view of Shimizu et al teach all the limitations of claim 3. Further Shimizu et al disclose a communication terminal according to claim 3 characterized in that the informing means is a buzzer (column 6, lines 15-20).

Regarding claim 6, Fukuda in view of Shimizu et al teach all the limitations of claim 3. Further Shimizu et al disclose a communication terminal according to claim 3 characterized in that the informing means is the display (column 4, lines 37-40).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 6414759 to Ikegami et al.

Regarding claim 11, Fukuda teach all the limitations of claim 10. However Fukuda does not disclose a communication terminal further comprising: a setting means for setting whether or not the melody which indicates the closing of the circuit, to be output, wherein the control unit outputs from the speaker the said melody based on a setting of the setting means.

Ikegami et al disclose a communication terminal further comprising: a setting means for setting whether or not the melody which indicates the closing of the circuit, to be output, wherein the control unit outputs from the speaker the said melody based on a

setting of the setting means (column 3, lines 41-46. Since Ikegami et al disclose that the user has option to be notified of a disconnection either by display, alarm sound or voice, Ikegami et al implies an option for setting the method of notification. ).

Fukuda and Ikegami et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the melody setting of Ikegami et al with the system of Fukuda to implement setting for melody for the closing of a circuit.

The motivation to combine the reference is clear because a user has option for the method of notification of a closing of the circuit.

8. Claims 14 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 4638368 to Shimizu et al further in view of U.S. Patent No. 5675421 to Ouchi.

Regarding claim 14, Fukuda in view of Shimizu et al teach all the limitations of claim 1. However Fukuda in view of Shimizu et al does not disclose a communication terminal according to claim 1 characterized in that the control unit maintains the state of closing the circuit with the network control unit when the recording unit fails to operate and a image memory is overflowed, comprising: said image memory.

Ouchi discloses a communication terminal according to claim 1 characterized in that the control unit maintains the state of closing the circuit with the network control unit when the recording unit fails to operate and a image memory is overflowed, comprising: said image memory (column 11, lines 21-27).

Fukuda, Shimizu et al, and Ouchi are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the communication terminal of Ouchi with the system of Fukuda in view of Shimizu et al to implement closing of circuit when recording unit fails and image memory is full.

The motivation to combine the reference is clear because when recording unit fails and image memory is full the facsimile needs to be shut down since either recording unit or image memory is needed to receive data.

Regarding claim 4, Fukuda in view of Shimizu et al teach all the limitations of claim 1. Further Ouchi disclose a communication terminal comprising: a setting means for setting whether or not the circuit is to be closed when the recording unit fails to operate, wherein the control unit makes the network control unit close the circuit according to a setting of the setting means in the case the recording unit fails to operate (column 6, lines 40-57; The remote operation mode turned off determines setting of closing the circuit when recording and memory unit fails.).

9. Claims 7, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 6434343 to Kobayashi et al.

Regarding claims 7 and 8, Fukuda discloses a communication terminal comprising: a network control unit for closing and releasing a circuit (page 7, lines 13-14, reference 233);

an operating key for making the network control unit release the circuit (It would be inherent that a hook key which reads on operating key is used to release the circuit of the facsimile system of Fukuda (page 7, lines 12-13));

a recording unit for recording image data in a recording medium (page 7, line 10, reference 215); and

a control unit which refuses an incoming call by maintaining the state of closing the circuit with the network control unit (page 7, lines 15-16; page 8, lines 18-21, reference 231). However Fukuda does not disclose an informing unit or a display unit for informing or displaying functions capable of being used on the informing/display unit, in the case the recording unit fails to operate.

Kobayashi et al disclose an informing unit/display unit (column 10, lines 26-31) for informing or displaying functions capable of being used on the informing/display unit in the case the recording unit fails to operate (column 11, lines 31-40).

Fukuda and Kobayashi et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the informing unit/display of Kobayashi et al with the system of Fukuda to implement display of functions capable of being used.

The motivation to combine the reference is clear because a user needs to know the status of the communication terminal before use (Kobayashi et al: column 11, lines 31-40).

Regarding claim 9, Fukuda in view of Kobayashi et al teach all the limitations of claim 8. Further Kobayashi et al disclose a communication terminal according to claim 8 characterized in that a message which indicates that a facsimile transmission or a telephone is capable of being carried out, is displayed (column 13, lines 30-32).

10. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 6434343 to Kobayashi et al further in view of U.S. Patent No. 5675421 to Ouchi.

Regarding claims 15 and 16, Fukuda in view of Kobayashi et al teach all the limitations of claims 7 and 8 respectively. However Fukuda in view of Kobayashi et al does not disclose a communication terminal characterized in that the control unit maintains the state of closing the circuit with the network control unit when the recording unit fails to operate and a image memory is overflowed, comprising said image memory.

Ouchi disclose a communication terminal characterized in that the control unit maintains the state of closing the circuit with the network control unit when the recording unit fails to operate and a image memory is overflowed, comprising said image memory (column 11, lines 21-27).

Fukuda, Kobayashi et al, and Ouchi are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the closing of circuit when recording unit fails and image memory is full as taught by Ouchi with the system of Fukuda in view of Kobayashi et al.

The motivation to combine the reference is clear because when recording unit fails and image memory is full the facsimile needs to be shut down since either recording unit or image memory is needed to receive data.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 6434343 to Kobayashi et al further in view of U.S. Patent No. 6701095 to Fujimoto et al.

Regarding claim 12, Fukuda in view of Kobayashi et al teach all the limitations of claim 7. However Fukuda in view of Kobayashi et al does not disclose a communication terminal according to claim 7 characterized in that the functions capable of being used is informed in a voice message.

Fujimoto et al disclose a communication terminal characterized in that the functions capable of being used is informed in a voice message (column 31, lines 53-67).

Fukuda, Kobayashi et al, and Fujimoto et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the voice messaging of capable functions of Fujimoto et al with the system of Fukuda in view of Kobayashi et al to enable users to hear messages related to the functions of the facsimile device.

The motivation to combine the reference is clear because voice message provides an alternative to informing users of the status of a facsimile machine.

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 5675421 to Ouchi.

Regarding claim 17, Fukuda teaches all the limitations of claim 10. Fukuda discloses a communication terminal according to claim 10 characterized in that the control unit maintains the state of closing the circuit with the network control unit when the recording unit fails to operate. However Fukuda does not disclose a communication terminal according to claim 10 characterized in that the control unit maintains the state of closing the circuit with the network control unit when an image memory is overflowed, comprising: said image memory

Ouchi disclose a communication terminal characterized in that the control unit maintains the state of closing the circuit with the network control unit when an image memory is overflowed, comprising: said image memory (column 11, lines 21-27).

Fukuda and Ouchi are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the closing of the circuit as taught by Ouchi with the facsimile system of Fukuda to implement circuit closing during memory full and when recording unit fails.

The motivation to combine the reference is clear because when recording unit fails and image memory is full the facsimile needs to be shut down since either recording unit or image memory is needed to receive data.

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP401318456A to Fukuda in view of U.S. Patent No. 6414759 to Ikegami et al further in view of U.S. Patent No. 6728534 to Izumi et al.

Regarding claim 13, Fukuda in view of Ikegami et al teach all the limitations of claim 11. However Fukuda in view of Ikegami et al does not disclose a communication terminal according to claim 11 characterized in that the circuit closing melody of which is different from the melody of the holding melody output when holding a telephone conversation, is output from the speaker.

Izumi et al disclose holding melody generator (Figure 2, reference 216) that generates melody during holding (column 9, lines 14-24). In combination with the system of Ikegami et al, the closing melody as set in Ikegami et al (for example using a voice) can be set differently than the holding melody as set by Izumi et al.

Fukuda, Ikegami et al, Izumi et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the holding melody of Izumi et al with the facsimile system of Fukuda in view of Ikegami et al to implement different melody output during circuit closing and holding.

The motivation to combine the reference is clear because different melodies are necessary to inform user of different events.

***Other Prior Art Cited***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5717493 to Ozawa et al disclose a communication system which disconnects during failures such as lack of paper.

***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>.

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**Patent Examiner**

Beniyam Menberu

BM

01/18/2006

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